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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/844,662

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Eva Raschke

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EXAMINER

KELLY, ROBERT M

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 09/844,662</p>	<p><b>Applicant(s)</b> RASCHKE ET AL.</p>	
	<p><b>Examiner</b> ROBERT M. KELLY</p>	<p><b>Art Unit</b> 1633</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☒ Other: It is noted that no amendments were proposed at this time, and hence, item 7, above, has not been addressed. However, for clarity, it is noted that the rejections under double-patenting against 7,026,462 and 7,163,824 are withdrawn, and hence, should not be addressed in the appeal.

/Robert M Kelly/  
Examiner of Art Unit 1633

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's filing of Terminal Disclaimers to 7,026,467 and 7,163,824 overcomes the rejections for double patenting and as anticipated under 102(e), and hence, such rejections are withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that there was a restriction requirement in the instant case, on April 7, 2004, which was made FINAL in the Official Action of 7/26/04, which does not transform the restriction requirement to an election of species (pp. 2-3). Such is not what the Examiner is saying. The statement is that the Applications which are used to make the double-patenting rejections did not have a restriction requirement. Applicant is clearly not understanding what is being said. The instant Application's restriction requirement is not relevant to a consideration of double-patenting against the instant Application. It is whether or not a restriction requirement was imposed in the application of the claims which are recited as causing the rejection. The double patenting rejection is based on an improper extension of termwise-rights. In the instant case, in each patent, the complex is made in the process of the methods, or the method of making the zinc finger is taught by the specification to be utilized to make the complex, in affecting various processes in the cell. In none of these other patents, was there a restriction requirement issued that was held through prosecution to exclude the complex presently made. Hence, in each of these instances, the complex is made during the process, or as the continuation of the process of making claimed. Therefore, these complexes could have been claimed in the other patents/Applications, and could have been restricted from the invention issued as patent, however, Applicant chose not to claim such. In any case, it amounts to an improper term-wise extension of term-wise rights. Lastly, to answer the direct question raised in Applicant's response, it is not the restriction in the instant Application, but the restriction requirement(s) present in the OTHER Patent/Application or their direct parent which is required to be considered (e.g., 35 USC 121; MPEP 802). For more elucidation of such, Applicant is requested to review MPEP 800, et seq. To wit, MPEP 804, as quoted by Applicant does not say that the issuance of restriction requirement precludes double-patenting against other Applications/Patents drawn to distinct subject matter, but that the restricted case cannot be used as Art against other Applications/Patents. Applicant again argues that the patents cited as 102 anticipation rejections do not teach that the zinc fingers are necessarily and inevitably bound to accessible regions, that accessible rejections are distinct from any region which the finger can bind, and that therefore the claims are not anticipated. Such is not persuasive. Applicant's cited definition states that the region is "generally" one that does not have a typical nucleosomal structure. It does not exclude that those do have such structure, and hence, the evidence of non-accessible regions is irrelevant. Second, the definition appears to actually conflict with the definition on page 11, paragraph 2, which states that the site is any site which can be bound in chromatin, and "without wishing to be bound by any particular theory, it is BELIEVED that an accessible region is one that is not packaged into a nucleosomal structure". This seems to indicate that Applicant does not even know what an accessible region is. Anyway, the broadest reasonable interpretation of such limitation is that the accessible region is any portion to which the zinc finger will bind, as was previously argued. Hence, these rejections remain.